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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,291	02/11/2002	Patrice J. McCune	MA-12918	2439

7590

03-12-2003

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EXAMINER

VO, HAI

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 03/12/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,291

Applicant(s)

MCCUNE, PATRICE J.

Examiner

Hai Vo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 16-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-15, drawn to a sheet material, classified in class 428, subclass 304.4+.
 - II. Claims 16-31, drawn to a method of making a sheet material, classified in class 264, subclass various.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as one that attaches a plastic film coated with a primer to a preformed foam so as to eliminate a final step of curing an aqueous polymer dispersion to foam.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
3. During a telephone conversation with Thomas Young on 02/10/2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-15. Affirmation of this election must be made by applicant in replying

to this Office action. Claims 16-31 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

4. Claim 7 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 4. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).
5. Claim 8 is objected to because of the following informalities: Claim 8 has an improper dependency. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hawley (US 5,854,144). Since the claims do not require a continuous foam layer is adjacent to a plastic top film. Hawley reads on the claim limitations. Hawley teaches a sheet material having a smooth top layer 12, a polyester fabric intermediate layer 14 and a continuous bottom foam layer 16 (abstract, column 2, line 66 et seq.). It is the examiner's position that Hawley anticipates the claimed subject matter.

8. Claims 1-4, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Alderfer (US 3,223,568). Alderfer teaches a foam film laminate having a top polyethylene layer directly extruded onto a bottom polyurethane foam layer (column 3, lines 2 and 20-22). The film has been treated with flame to promote adhesion (column 3, lines 29-31). Since the foam film laminate of Alderfer meets the recited structure of the claims (plastic film/ foam and film having skin characteristics enhancing adhesion of foam layer, it is the examiner's position that the laminate would inherently not curl when laid flat as the sheet material of the present invention. It is the examiner's position that Alderfer anticipates the claimed subject matter.
9. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Breitscheidel et al (US 4,917,944). Breitscheidel teaches a plasticizer-free laminate having an EPDM/PP directly bonded to a crosslinked polyolefin foam layer (abstract). The laminate has been treated with flame to promote adhesion (column 9, line 65 et seq.). The foam layer contains styrene-butadiene rubber (column 8, lines 10-12). Since the foam film laminate of Breitscheidel meets the recited structure of the claims (plastic film/ foam and film having skin characteristics enhancing adhesion of foam layer, it is the examiner's position that the laminate would inherently not curl when laid flat as the sheet material of the present invention. It is the examiner's position that Breitscheidel anticipates the claimed subject matter.

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10. Claims 1, 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Neuhaus et al (US 5,296,181). Neuhaus teaches a laminate having a covering layer directly bonded to a polyurethane foam layer (abstract). The covering layer is coated with a primer (column 5, lines 40-45). It is the examiner's position that Neuhaus anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alderfer (US 3,223,568). Alderfer teaches the foam having a thickness of 1 to 10mils (column 4, lines 18-20). Since the foam thickness is not critical to providing unexpected technical advantages and the laminate of Alderfer is widely used in variety applications, such a variable would have been recognized by one skilled in the art as dependent upon the intended use of the product. In an absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the foam layer having the thickness instantly claimed to impart the cushioning effect of the laminate.

13. Claims 5, 6, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alderfer (US 3,223,568) in view of Hartzell et al (US

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3,713,925). Alderfer is silent as to the foam layer made from a styrene butadiene foam. Hartzell discloses the foam substrate can be made of a polyurethane foam or a styrene butadiene foam (column 2, lines 3-12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the polyurethane foam by the styrene-butadiene foam because of its ready availability and economic advantage.

14. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breitscheidel et al (US 4,917,944). Breitscheidel discloses the foam layer having a thickness of 2 to 20mm (column 9, line 66) and the film layer with a thickness of 0.3 mm (example 3). Since the thickness is not critical to providing unexpected technical advantages and the laminate of Breitscheidel is widely used in variety applications, such a variable would have been recognized by one skilled in the art as dependent upon the intended use of the product. In an absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the foam layer and the film layer having the thickness instantly claimed to impart the strength of the laminate and improve its suitability to its intended use.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
March 6, 2003



TERREL MORRIS
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